

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) CS23014RL	
<p>I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 [(37 CFR 1.8(a)].</p> <p>on: _____</p> <p>Signature _____</p> <p>Typed or printed name _____</p>		Application Number 10/812,285	Filed 03/29/2004
<p>First Named Inventor Arneson, Theodore</p>			
Art Unit 2617	Examiner Cai, Wayne Huu		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p><input checked="" type="checkbox"/> This request is being filed with a notice of appeal.</p> <p><input checked="" type="checkbox"/> The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant inventor. _____ /Sylvia Chen/ _____ Signature</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. _____ (Form PTO/SB/96) _____ Sylvia Chen _____ Typed or printed name</p> <p><input checked="" type="checkbox"/> attorney or agent of record. Registration number <u>39,633</u> _____ 847-523-1096 _____ Telephone number</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34: _____ 05/31/2007 _____ Date</p>			
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*</p>			

*Total of 1 forms are submitted.

(SB/33 (07-05))

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT: Theodore R. Arneson et al. ART UNIT: 2617
APPLN. NO.: 10/812,285 EXAMINER: CAI, WAYNE HUU
FILED: 03/29/2004
TITLE: AMBULATORY HANDHELD ELECTRONIC DEVICE

REMARKS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully submits that the Examiner's April 9, 2007 Final Office Action and omits one or more essential elements needed for a *prima facie* rejection as well as contains a clear error because one or more limitations are not met by the cited references. Sole independent claim 14 stands rejected under 35 U.S.C. § 103(a) over US 2001/0023197 (Shibata) in view of EP 1222971 (Noro) and US 2004/0179710 (Farinelli).

An embodiment of the claimed subject matter is shown in FIG. 12 and includes a communication device 100 housing a controller 1204, a memory 1224, an audio system 210, 1234, 208, 1236, 206, 1206, and an ambulation system with four vibration transducers 302, 1246, 1248, 1250. FIGs. 2-3 show the ambulation system from a different perspective and include a first electromechanical ambulation mechanism 222 have a first foot 226 extending through a first opening 218 in the housing 102 that is driven by a first drive circuit 1214 (FIG. 12). The three other electromechanical ambulation mechanisms in FIG. 12 are similar to the first electromechanical ambulation mechanism 222. FIG. 16 shows how the controller can be programmed to drive the ambulation system in response to audio processed by the audio system.

Pages 3-4 of the Final Office Action note that neither Shibata nor Noro disclose “a first electromechanical ambulation mechanism having a first foot extending through a first opening in the housing for making contact with an external surface on which the handheld audio device is placed” as recited by independent claim 14 and looks to Farinelli for teaching this limitation. Farinelli teaches “a speaker system includes mounting hardware and audio components with a fastening arrangement that facilitates the fastening of the mounting hardware to a structure and the audio components to the mounting hardware.” See Farinelli Abstract. The Final Office Action goes on to mention that “a first electromechanical ambulation mechanism” of claim 14 corresponds to Farinelli’s speaker (presumably the baffle 102 of Farinelli which includes one or more speaker cones). See Farinelli paragraph [0026].

The Final Office Action omits one or more essential elements needed for a *prima facie* rejection because the cited references, singly and in combination, fail to show or suggest “a first electromechanical ambulation mechanism having a first foot extending through a first opening in the housing” as recited in claim 14. “Ambulate” is defined by the American Heritage Dictionary of the English Language, Fourth Edition 2004 as “to walk from place to place; move about.” Applicant mentions that “the ambulation mechanisms enable the device to move (translate, rotate or execute compound movements) on a surface on which the device is placed.” See specification page 5 line 26- page 6 line 2. Farinelli’s speaker does not correspond to the “ambulation mechanism” of the claims because the speaker does not enable any device to move (ambulate). Although a speaker cone vibrates to produce sound, it does not move (ambulate).

Applicant is bewildered by the Final Office Action statement that “the speaker of Farinelli is broadly and reasonably considered or interpreted as ‘electromechanical ambulation mechanism’ because the speaker is the electromechanical mechanism as well known in the art.” Applicant agrees that a speaker is an electromechanical

mechanism, but disagrees with the Examiner's assumption that an electromechanical mechanism is necessarily an electromechanical ambulation mechanism.

Moreover, the Office Action equates "a first foot" of claim 14 to Farinelli's screw 106. Farinelli's screw 106 is used for mounting the speaker on a wall or ceiling and actually teaches away from an "ambulation mechanism" as recited in claim 14. See Farinelli paragraphs [0010], [0023], [0039], and others. A screw *prevents* ambulation. Thus, the cited references fail to show or suggest an "electromechanical ambulation mechanism" and the Final Office Action omits one or more essential elements needed for a *prima facie* rejection of sole independent claim 14.

Also, the Final Office Action contains a clear error because it improperly combines the three cited references. Shibata and Noro both contemplate mobile phones with standard (internal) vibrators and speakers. Farinelli discusses a wall-mounted speaker system. There is no reasonable expectation of success when combining the cited references. Mounting a speaker, in accordance with Farinelli, of a portable electronic device such as the ones shown in Shibata and Noro makes the devices no longer portable. Also, affixing the speaker 110 of Shibata to a wall or ceiling, according to the teachings of Farinelli, will destroy any vibrational effect of Shibata and Noro.

Conclusion

Reconsideration and withdrawal of the rejection of independent claim 14 under 35 U.S.C. § 103(a) as being obvious in view of any combination of Shibata, Noro, and Farinelli is respectfully requested. Because the independent claim is not properly rejected, the rejection of the dependent claims should also be withdrawn.

S U M M A R Y

The application is in condition for allowance and a favorable response at an early date is earnestly solicited. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact Applicants' representative at the telephone number indicated below.

Please charge any fees associated herewith, including extension of time fees, to
Deposit Account 502117.

Respectfully submitted,

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